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Juli Delin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT application of:

)

April Gulbrandson KOHRT

) Examiner: H. T. Vo

Serial No. 08/951,754

) Art Unit No. 3402

Filed: October 16, 1997

)

For: INTAKE AIR HEATER AND

)

AIR DELIVERY ASSEMBLY

)

FOR ENGINES

)

)

Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

**STATEMENT OF JUSTIFICATION
FOR DECLARATION OF INTERFERENCE
UNDER CFR §1.608(b)**

Applicant by this explanation along with its attached declarations and documentary exhibits, makes a *prima facie* showing that she is entitled to a date of conception prior to June 22, 1995, as to all the copied claims. Specifically, for the purposes of this *prima facie* showing, Applicant presents evidence establishing at least the following dates:

April 26, 1994 - Conception

April 27, 1994 - Inventive concept communicated to patentee

April 1994 - November 1995 - Diligence to constructive reduction to practice

November 23, 1994 - Actual reduction to practice

November 3, 1995 - Constructive Reduction to Practice

Applicant has further made out a *prima facie* case that shows that the elements of the claims (1-23) of U.S. Patent No. 5,595,164 to Thimmesch (assigned to Phillips & Temro Industries, Inc.) are derived entirely from the inventive activity of the present applicant while an employee of the assignee of the subject invention, Cummins Engine Company, Inc., which inventive information was disclosed to Phillips & Temro, a Cummins supplier, in confidence prior to applicant's own patent application filing pursuant to an agreement entered into between Cummins and Phillips & Temro. (See, Seat Decl. at Exhibit A).

In the alternative, Applicant has made out a *prima facie* case that shows that, as a matter of law, the acts of Phillips & Temro should accrue to the benefit of the Applicant. That is, even if the Applicant did not personally communicate the conception of the invention to Jan Thimmesch, Phillips & Temro was working either explicitly or implicitly at the request of Applicant's employer. Therefore, Phillips & Temro's activities to reduce the invention to practice, inure to the benefit of Applicant. (See, Kohrt Decl. para. 7 and Exhibit A of Seat Decl.)

For the reasons recited herein, based on the declarations and supporting evidence submitted, it is respectfully submitted that there are

multiple grounds upon which Applicant is entitled to a judgment of inventorship against Phillips & Temro.

Applicant is alleging these dates of conception, diligence and actual reduction to practice for purposes of presenting a *prima facie* case only, and Applicant reserves the right to allege earlier dates in her Preliminary Statement.

I. Declarations

In support of these dates, Applicant presents the following declarations:

Exhibit 1, Declaration of April G. Kohrt, chief design engineer on the assignee's Intake Air Heater project on which present application was filed and from which the subject invention arose;

Exhibit 2, Declaration of Sean C. Milloy, Chief Engineer on C-Series Engine. Mr. Milloy was in charge of the entire development effort for the C-Series Engine. Part of his duties entailed gathering and maintaining an updated status of the development progress on the C-Series Engine;

Exhibit 3, Declaration of Sam T. Inoue, Technical Leader for Application Engineering of Japanese Market. Mr. Inoue prepared the formal documentation necessary to approve and track all project change requests (PCRs);

Exhibit 4, Declaration of Robert H. Seat, Commodities Manager at Cummins. Mr. Seat was the primary interface for Phillips & Temro at Cummins on sourcing and concurrent engineering issues that arose between Cummins and Phillips & Temro.

These individuals provide statements to corroborate and support conception, diligence, reduction to practice, full scale engineering production of the air heater and derivation. They also authenticate and explain documents attached to their declarations as exhibits.

II. Overview

The development effort for the assignee's (Cummins Engine Company, Inc.) Intake Air Heater and Air Delivery Assembly for Engines began in April 1993, well in advance of the June 22, 1995 filing date of the Thimmesch patent. It began as a customer request for a device to use in the assignee's C-Series internal combustion engine for heating the airflow entering the cylinder head from the intake manifold. (See, Inoue Decl. para. 4 and Exhibit A, and Milloy Decl. para. 6). The conception of the invention embodied in the present application occurred at least by April 26, 1994, as evidenced by the drawing prepared prior to, and discussed at the design review on April 27, 1994. (See, Kohrt Decl. At Exhibit D). The design review minutes were prepared and distributed on April 28, 1994 (See, Kohrt Decl. at Exhibit E). This design review stimulated a large development effort in which Cummins, the intended assignee of the invention, enlisted specialized assistance from outside contractors (e.g., Phillips & Temro), as well as its own wholly owned subsidiaries. (Kohrt Decl. para. 7).

conception

Prior to their participation in this development effort, Phillips & Temro entered into a supplemental agreement with Cummins in which they agreed to not disclose confidential information learned from Cummins in the course of this development effort. (See, Seat Decl. at para 3 and Exhibit A). Numerous individuals were involved in the project, and from the April 1994 design review until the August 1995 completion of the development effort,

these individuals aggressively pursued both completion of the intake air heater engineering development as well as commencement of full scale production which was slated to start as early as December 1994. (See, Inoue Decl. at Exhibit A, Milloy Decl. at paras. 9-12, and Kohrt Decl. at paras. 6-12). In October 1995, assignee retained the services of a patent attorney to prepare a patent application describing the device and on November 3, 1995, an application was filed. (Kohrt Decl. at para. 14).

III. Conception

The invention described and now claimed in the present application was conceived at least by April 1994 which predates the June 22, 1995 filing date of the Thimmesch patent application on which the Thimmesch patent issued. In April 1994, April Kohrt prepared a drawing evidencing conception of the invention. (See, drawing attached as Exhibit D of Kohrt Decl.) This document is authenticated and explained by Ms. Kohrt in her declaration. (See, Kohrt Decl. para. 6). The drawing was disclosed at a design review on April 27, 1994 that addressed design changes necessary to enhance performance and reduce the cost of the intake heater. (Kohrt Decl. at Exhibit E). The rudimentary drawing of the intake frame presented at the design review illustrates the broad concept of a frame with a recessed body portion that is to be placed inside the cylinder head. As noted in the declarations, this presentation shows conception of the invention. Further, a refined concept for the air heater was completed by September 27, 1994. (Refined concept attached as Exhibit H of Kohrt Decl.) Thus the invention was conceived by at least April 26, 1994 (date of initial drawing) and was more clearly conceived by at least September 27, 1994 (date of refined drawing).

IV. Diligence

First, Applicant notes that diligence was occurring at all times, from well in advance of June 22, 1995, the filing date of the Thimmesch patent until the filing of the Applicant's patent application on November 3, 1995. In fact, from the April 1994 conception until October 27, 1995, work proceeded on various aspects of the apparatus necessary to prepare the device for production. (See, Kohrt Decl. para. 6-14 and Milloy Decl. paras. 10-12). By September 27, 1994, Applicant had prepared engineering drawings reflecting a refined concept for the intake air heater. (Kohrt Decl. at Exhibit H). On November 23, 1994, the first prototype of an intake air heater recessed into the manifold was received by the Applicant. (See, Kohrt Decl. at Exhibit G). As noted by the revision dates on the various drawings depicting the evolution of the intake air heater (See, Kohrt Decl. Exhibits D, H and K), Applicant systematically continued to make revisions to the invention until March 2, 1995, when she prepared Engineering Release No. 953068-056 which signified the end of engineering development. (Kohrt Decl. at para. 11 and Exhibit I). The device was subsequently approved for production on August 15, 1995. (Kohrt Decl. at para. 12 and Exhibit J). On October 27, 1995, Ms. Kohrt sent several drawings to Tim Brackett, a patent attorney, that provided him with the information necessary to draft the application that was filed on November 3, 1995. (See, Kohrt Decl. para. 14 and Exhibit M).

V. Reduction to Practice plus no Abandonment, Suppression or Concealment

Applicant notes that because diligence was continuous from at least June 21, 1995 (the day before the filing of the Thimmesch patent) until the filing date of Applicant's patent application on November 3, 1995, (See supra part IV), no showing of actual reduction to practice is necessary. However, Applicant's invention was actually reduced to practice on November 23, 1994 when a prototype of the device was shipped to Cummins. (See, Kohrt Decl. paras. 9-10 and Exhibits G-H). Moreover, the invention was disclosed to the public on or about August 1995, when it began to be included in production models of the C-Series engines. (Kohrt Decl. para. 16). Furthermore, this continuous activity set forth in detail above and the filing of the subject application on November 3, 1995, establishes that there was no abandonment, suppression, or concealment of the invention.

VI. Derivation

As indicated by the Declaration of April G. Kohrt and the Declaration of Sean Milloy, Applicant (Ms. Kohrt), and not Jan P. Thimmesch, is the inventor of the subject matter claimed in the interfering patent. Specifically, the evidence shows that the disclosure and claims of the Thimmesch patent are derived entirely from the inventive activity of the present applicant. The inventive information was disclosed to Phillips & Temro in confidence at least as early as April 27, 1994, pursuant to the Supplemental Agreement entered into by Phillips & Temro on November 5, 1993, at a design review prior to applicant's own patent application filing. (See, Kohrt Decl. para.

7 and Seat Decl at Exhibit A). Moreover, Applicant personally provided information to Jan Thimmesch from at least as early as September 28, 1994 (almost 9 months prior to the filing date of the Thimmesch patent.) (Kohrt Decl at para. 15 and Exhibit M).

VII. Inurement

Even if it is found that the patentee did not personally derive the invention from Applicant, as a matter of law, the acts of Phillips & Temro as described in the Declaration of April Kohrt and Sean Milloy accrue to the benefit of Cummins. Specifically, the evidence shows that on November 3, 1993, Phillips & Temro entered into a supplemental agreement with Cummins that protected Cummins' rights to confidential information communicated to Phillips & Temro in the regular course of business and also allowed Phillips & Temro to satisfactorily fulfill their obligations as a Cummins supplier. (See, Seat Decl. at Exhibit A). On April 27, 1994, representatives from Phillips & Temro attended a design review in which the inventor of the present invention, revealed confidential information specifically related to the subject invention. (See, Kohrt Decl. para. 7 and Exhibit E). From at least as early as September 28, 1994, Applicant regularly sent email messages to Jan Thimmesch, inviting the Phillips & Temro employee to several Intake Air Heater meetings and informing him of critical milestone dates in the intake air heater development process. (Kohrt Decl. para 14 and Exhibit L).

On June 22, 1995, Jan Thimmesch filed the patent application which matured into the patent that is the subject of this prospective interference. Under the terms of the Supplemental Agreement, Phillips & Temro agreed

that all inventions conceived by Cummins, in the course of work performed under the Supplemental Agreement, shall belong to Cummins. Therefore, the patentable subject matter contained in the interfering patent that was communicated to Phillips & Temro, inures to the benefit of the inventor for purposes of establishing a reduction to practice. Cooper v. Goldfarb, 47 U.S.P.Q.2d 1896, 1904 (Fed. Cir. 1998). (See, Kohrt Decl. para. 7, Milloy Decl. para. 8 and Seat Decl. at Exhibit A)

VIII. Conclusion

The foregoing, along with the Declarations and Exhibits, establishes that Applicant is entitled to priority over the Phillips & Temro patent. This information combines to form a *prima facie* case. Taking these declarations (with Exhibits) as true, they establish that the inventor and those working with her conceived of the invention at least prior to the patentee's filing date of June 22, 1995, and diligently worked toward the constructive reduction to practice on November 3, 1995. There was no abandonment, suppression or concealment as evidenced by the inclusion of the subject device in production C-Series engines on or about August 1995, and the filing of the subject patent application on November 3, 1995. The Declarations and Exhibits additionally establish that the patentee did not invent the invention disclosed in the count because the patentee derived the invention from the applicant. In the alternative, even if the patentee did not personally derive the invention from the Applicant, the acts of Phillips & Temro on this project, inure to the benefit of Cummins.

For all these reasons, Applicant respectfully requests that an interference be declared and that the *prima facie* showing be deemed sufficient.

Respectfully submitted,



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